

**REMARKS**

The Office Action mailed 29 July 2005 has been reviewed, and the comments of the U.S. Patent Office have been considered. Claims 1-9 are respectfully submitted for reconsideration by the Examiner. The Examiner is thanked for removing the previous Office Action issued on 24 August 2004.

**Summary of the Office Action**

Claims 1-5 and 8-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. 0464278 to *Wake et al.* ("*Wake*") in view of U.S. Patent No. 4,837,567 to *Kleefeldt et al.* ("*Kleefeldt*").

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wake* in view of *Kleefeldt* and in further view of Great Britain Patent No. 216965A1 to *Mullin et al.* ("*Mullin*").

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Wake* in view of *Kleefeldt* and in further view of U.S. Patent No. 5,974,661 to *Neuhalfen*.

**Summary of the Response to the Office Action**

Applicants respectfully submit that the combination of features of the present invention are not taught or suggested by the applied references. Accordingly, claims 1-9 are pending for further consideration.

**All Subject Matter Complies with 35 U.S.C. § 103(a)**

Claims 1-5 and 8-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wake* in view of *Kleefeldt*. Applicants respectfully traverse the rejection for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action fails to meet these criteria. The Office Action fails to establish that there was some suggestion or motivation to combine the reference teachings. The Office Action states that the “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the magnetic key of Wake to be replaced by the electronic key of Kleefeldt, because both key types cannot be duplicated as a means to prevent unauthorized users from attempting to steal the vehicle.” However, the alleged key types are very different and are not interchangeable.

As such, the suggestion or motivation to combine is not provided by either the references themselves or by knowledge generally available to one of ordinary skill in the art. Therefore, it is respectfully submitted that the statement in the Office Action is not sufficient by itself to meet the first prong of *prima facie* obviousness. In fact, the MPEP § 2143.01 states that “the level of skill in the art cannot be relied upon to provide the suggestion to combine references.” *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Second, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to the references of record that shows the desirability of combining *Wake* and *Kleefeldt*. The mere assertion that references could be combined is not sufficient by itself to establish *prima facie* obviousness. Therefore,

it is respectfully submitted that the Office Action has not met the second prong of *prima facie* obviousness.

Third, the Office Action has not established a *prima facie* case of obviousness at least because neither *Wake* nor *Kleefeldt*, whether alone or in combination, teach or suggest all the recited features of independent claim 1. Namely, neither *Wake* nor *Kleefeldt* teach or suggest at least “a blocking element (17), which executes an adjusting movement on introduction of the key (2) into the holder (11) and/or removal of the key (2) from the holder (11), interacts with the holder (11) in such a manner that the movement of the holder (11) additionally to its release is made possible only when the key (2) is correctly in the holder (11), wherein a separate transmitting means (25) for the adjusting movement of the blocking element (17) can be brought into operative connection with the blocking element (17) at one end and with the switching element (16) at the other end, and wherein the adjusting movement of the blocking element (17) causes the transmitting means (25) to exert a switching action on the switching element (16),” as recited in independent claim 1.

Applicants respectfully submit that the structure identified in *Wake* cannot satisfy the requirements recited in independent claim 1. For example, the “movable obstruction elements 9” and “magnetic responsive switch 11” discussed in *Wake* cannot be the “blocking element (17)” and “switching element (16),” of the present invention because the movable obstruction element 9 of *Wake* does not “cause [a] transmitting means (25) to exert a switching action on the switching element.” Furthermore, the Office Action fails to mention “a separate transmitting means (25),” like that recited in independent claim 1.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully

assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Wake* and *Kleefeldt* do not teach or suggest each and every feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claims 2-5 and 8-9 are also allowable insofar as they recite the patentable combination of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wake* in view of *Kleefeldt* and in further view of *Mullin*. Applicants respectfully traverse the rejection for at least the following reasons.

The Office Action allegedly combines the holder of *Wake* with the cam of *Mullin* to arrive at the present invention. However, the *Mullin* cam cannot be combined with the blocking elements of *Wake*, as recited in claim 6. That is, the cam and blocking elements would not be functional when combined because they would not be located close enough to each other when combined to operate. Further, the components are utilized for different reasons altogether and there is no suggestion or motivation in the art or in the references themselves to combine them.

*Mullin* is only relied upon for the cam. *Mullin* does not make-up for the above-mentioned deficiencies of *Wake* and *Kleefeldt*. Thus, Applicants respectfully submit that none of the references of record teach or suggest at least the above-mentioned features recited in independent claim 1. Accordingly, Applicants respectfully request that all rejections under 35 U.S.C. § 103(a) should be withdrawn.

In view of the above arguments, Applicants respectfully request that the rejection of dependent claim 6 under 35 U.S.C. § 103(a) be withdrawn. Claim 6, which depends from

independent claim 1, is allowable at least because its base claims are allowable, as well as for the additional features recited therein.

Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Wake* in view of *Kleefeldt* and in further view of *Neuhalfen*. Applicants respectfully traverse the rejection for the following reasons.

The Office Action allegedly combines the push button feature of *Wake* with the surface mount device (SMD) of *Neuhalfen* to arrive at the present invention. However, the SMD technology of *Neuhalfen* cannot be combined with the push button of *Wake* as recited in claim 7. That is, the surface mounted circuit protector of *Neuhalfen* has no nexus with the “push button 29” discussed in *Wake*. In fact, it is merely because the terms “SMD” and “push button” appear in both references that these references were combined. Applicants respectfully submit that there is no suggestion or motivation in the art or in the references themselves to combine.

*Neuhalfen* is only relied upon for the SMD. *Neuhalfen* does not make-up for the deficiencies of *Wake* and *Kleefeldt*. Thus, Applicants respectfully submit that none of the references of record teach or suggest at least the above-mentioned features recited in independent claim 1. Accordingly, Applicants respectfully request that all rejections under 35 U.S.C. § 103(a) should be withdrawn.

In view of the above arguments, Applicants respectfully request that the rejection of dependent claim 7 under 35 U.S.C. § 103(a) be withdrawn. Claim 7, which depends from independent claim 1, is allowable at least because its base claims is allowable, as well as for the additional features recited therein.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,  
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